



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,764	06/23/2003	Eddy Lambert	016782-0280	5710
22428	7590	02/13/2006	EXAMINER	
FOLEY AND LARDNER LLP			COLE, ELIZABETH M	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			1771	

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,764

Applicant(s)

LAMBERT ET AL.

Examiner

Elizabeth M. Cole

Art Unit

1771

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 21-32, 34, 36, 38 and 41-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-20, 33, 35, 37, 39, 40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1771

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-8, 12-20,33,35,37,39,40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 29-35 of U.S. Patent No. 6,607,998. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims a burner membrane comprising at least one layer consisting of a needled fiber web which is compressed to a porosity of between 60% and 95%, and that is constructed of heat-resistant stainless steel fibers, wherein the fiber web is needled in one step and compressed in a different step.

Art Unit: 1771

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 12-20, 33, 35, 37, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0329863 in view of EP 0628146 in and Krupnik et al, U.S. Patent No. 6,298,538. EP'863 discloses a nonwoven web of stainless steel fibers which is suitable for use in combustion burners and filters. The nonwoven web comprises a plurality of fibers having a diameter of less than 100 micrometers which have rough outer surfaces. The fibers are randomly distributed and interlocked. Non-sintered webs may be used. See page 2, lines 1-16; page 2, line 55 – page 3, line 2. The density and pore size of the nonwoven web can be controlled by compacting by pressing or rolling the web. The examples set forth in table 1 show porosities of 47-7-85.7. The fiber web can have a weight of about 850-950 grams per square meter. See examples. EP '863 differs from the claimed invention because EP'863 does not teach that the fibers can be formed from shavings and does not disclose needling the web, although it does disclose that the fibers are interlocked. EP '146 discloses a burner membrane for a radiant burner comprising a compressed web of stainless steel fibers. The web has a porosity of about 78-88 percent. . The fibers can be formed from shavings. See example 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the fibers which were formed from shavings as taught by EP'146 in the invention of EP '863, motivated by the teaching that EP'146 teaches that

Art Unit: 1771

these types of fibers were recognized as useful in forming burner membranes. With regard to the needling, Krupnik teaches that needling nonwoven webs formed from metal fibers such as stainless steel fibers produces a stronger product. See abstract. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have needled the web of EP '863, in order to produce a stronger fabric.

6. Claims 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '863 in view of EP '146 and Krupnik as applied to claims above, and further in view of De Bruyne et al, U.S. Patent No. 5,088,919. EP '863 does not disclose coating the fibers with a coating that activates the oxidation of the burner fuel mixture. De Bruyne et al teaches that the fibers can be coated with a material which activates the oxidation of the burner fuel mixture. See col. 4, lines 35-49. It would have been obvious to one of ordinary skill in the art to have coated the fibers of EP '863 with the coating of De Bruyne et al, motivated by the expectation that this would enhance the heat resistance of the fibers.

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

8. It is noted that WO 98/37029 qualified as prior art under 102(a) because the publication date of WO '029, (8/27/98), is before the effective filing date of the instant application, (9/29/98), however, in the response to this rejection, Applicant has perfected their claim to foreign priority by providing a certified translation of the

Art Unit: 1771

reference, and therefore WO '029 no longer qualifies as prior art. However, the reference was properly applied in the previous action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.



Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c